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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,292	08/17/2001	Barbara J. Aalbers	56961US002	4777

7590 11/08/2002

Attention: Melissa E. Buss
Office of Intellectual Property Counsel
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P.O. Box 33427
St. Paul, MN 55133-3427

EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 11/08/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-53 is/are pending in the application.
- Of the above claim(s) 23-53 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-22 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2, 3, 4
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-22, drawn to rolls of contaminant removal tape, classified in Class 428, subclass 343.

II. Claims 23-53, drawn to contaminant removal tape assembly and accompanying methods of removing contaminants, classified in Class 15, subclass 104.002.

2. The inventions are distinct, each from the other because of the following reasons:

3. Inventions Group I and Group II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a roll of adhesive tape having a wide variety of utilities and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the

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prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Melissa Buss on November 4, 2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-22. Affirmation of this election must be made by applicant in replying to this Office action. Claims 23-53 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-22 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, in each of the independent claims (1 and 12), the phrase in the next to the last line "said roll includes a plurality of wraps of said tape" is vague and indefinite in that it has no apparent relationship to

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the "backing", and the claim should be amended in a manner so as to indicate, e.g. said backing includes a plurality of wraps, or similar language thereto. In claim 12, line 4 the phrase "discontinuous contact profile" is not believed to be distinguishable from the characterization of how the layer of adhesive is arranged in claim 1, subparagraph b. Clarification is requested.

8. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Gobran or Mazurek et al., each taken either individually, or in view of either Christensen or Cox et al. Each of the primary references appears to disclose (note particularly Gobran, the Figures, column 2 lines 26-28, line 53 - column 3 line 13, column 3 lines 23-32, line 57 - column 4 line 31, column 4 lines 43-68, Example 7 set forth particularly in Table 1 and at column 8 lines 23-25, as well as column 8 lines 7-9, column 9 lines 47-64, claim 1; Mazurek et

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al., the Abstract, the Figures, particularly Figures 2, 3a, 3b, 3c, column 1 lines 8-15, column 3 lines 21-36, column 7 lines 32-41, column 8 lines 12-62, column 10 line 65 - column 11 line 16, column 17 lines 18-36) substantial anticipations of not only applicant's independent claims, but also most of the dependent claims as well, except for the absence of both lines of perforations that would divide the tapes into segments (i.e. a plurality of wraps), together with an express teaching that the layer of adhesive must face outwardly away from the center of the roll. However, with respect to the presence of perforations or the like which divide the tape into segments, such a structure is believed to be well within the ordinary skill of the art in the adhesive tape roll art from which both references are taken, and certainly is well known in the art defined by applicant's claim preamble of a roll of contaminant removable tape. Alternatively, each of the secondary references clearly discloses (note particularly Christensen, elements 14 and column 1 lines 47-67; and Cox et al., element 26 in Figures 1 and 2 and column 3 lines 49-60) the missing presence of the lines of perforation dividing the tape into segments. With respect to whether the layer of coated adhesive faces either inwardly (as is generally the case in most pressure sensitive adhesive tapes) or outwardly (as is believed be the normal case in rolls of contaminant removable tape), this is believed to be a parameter that is well within the

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ordinary skill of the art in the broad field of rolls of adhesive tape and similar type tape structures, the particular direction in which the adhesive is facing being totally a function of the intended use of the tape. Note also that Gobran teaches that although in the rolls it discloses it is generally preferred to coat the adhesive on the smooth face of the foil (e.g. column 4 lines 24-30) there are definite advantages to coating the adhesive on the opposing textured face so that the outer surface of the adhesive would contact the smooth side of the backing when the tape is utilized in roll form. Also, the Examples set forth in Table 1 of the reference appear to be wound in conventional style with the adhesive on the smooth surface, but it must be noted that Example 7 applies the adhesive to the textured face instead of the smooth face and is silent with respect to whether or not the roll formed from the adhesive coated backing is wound with the adhesive facing outwardly away from the center of the roll or not. In any event, the Examiner repeats his contention that the direction in which the outer layer of adhesive faces in the roll structure is a parameter well within the ordinary skill of the art, in the absence of unexpected results. With respect to the dependent claims, as was briefly indicated above, these are believed to define well known structures that are also disclosed or clearly rendered obvious by the variety of structures set forth in each of the primary references.

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10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also Chang, Brown et al. -762 and -957.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

November 6, 2002

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1900-
1700

Daniel Zirker